

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of James McCOY, et al.

Application No. 09/785,010

Attorney Docket No. 350176-991101 (Formerly
A0647-991100)

Filed: February 16, 2001

For: EFFICIENT INTERNET SERVICE COST
RECOVERY SYSTEM AND METHOD

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Group Art Unit: 3621

Examiner: Elisca, Pierre E.

REPLY BRIEF

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Maria Paula Kovacs

Dear Sir/Madam:

This is a reply brief in response to the Examiner's Answer mailed July 6, 2007, and for an appeal from a Final Office Action dated January 9, 2006.

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I. APPELLANT'S REPLY

A. Claims 22 and 24-38 are patentable over Saylor.

The Examiner maintains that Claim 22 is unpatentable over U.S. Patent No. 6,888,929 B1 to Saylor (hereinafter “Saylor”) under 35 U.S.C. § 103(a). *See Examiner’s Answer at pp. 3-5.*

The Board should overturn this rejection because Saylor neither teaches nor suggests every element recited in each of the claims and there is no motivation to modify the relevant teachings of Saylor to practice every element recited in each of the claims. Moreover, the Examiner’s Answer fails to present evidence that Saylor discloses or suggests each and every element of the claims, and fails address all of the appellant’s arguments as to why Claim 22, and its dependent Claims 24-38, are patentable over Saylor.

1. **Saylor does not disclose contributing network resources to a network.**

Claim 22 recites that “network resources can be contributed to the network by one or more contributing computer systems,” where the network resources include “any of disk space, bandwidth, and CPU cycles.” Saylor does not disclose this claim limitation and the Examiner has not cited any evidence that shows otherwise.

As explained in the appellant’s appeal brief, Saylor discloses providing *content* to a voice network access provider (VNAP), but does not disclose providing *network resources* to a network. *Appeal Brief at p. 3.* The network resources of the present application (e.g., disk space, bandwidth, and CPU cycles) are not comparable to the content of Saylor (e.g., information about the Washington Monument and information about Monet’s *Water Lillies*). *Saylor at 8:59-9:23, 9:47-52.* Indeed, the present application’s specification even distinguishes between network resources and content. *See Appeal Brief at p. 3.*

The Examiner has not cited any evidence that shows otherwise. In the Examiner's Answer, he merely reiterates that *content* is provided to a VNAP. *Examiner's Answer at pp. 3-4* ("comprise a content provider," "input VPage content into the system," "providing pages of voice content," "the content provided by the provider"). Figures 14A and 14B of Saylor, also cited by the Examiner, also show nothing more than content being provided to a VNAP. The content in Saylor, however, is distinguishable from the network resources of the present application.

Because Saylor does not disclose contributing network resources to a network, it does not render obvious Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

2. Saylor does not disclose earning credits by contributing network resources to a network.

Claim 22 recites that "network resources can be contributed to the network by one or more contributing computer systems in return for a predetermined amount of credits," where the network resources include "any of disk space, bandwidth, and CPU cycles." Saylor does not disclose this claim limitation and the Examiner has not cited any evidence that shows otherwise.

As explained above, Saylor does not disclose contributing network resources to a network and, therefore, it does not disclose earning credits by contributing such resources. Moreover, even *assuming arguendo* that the content in Saylor is somehow comparable to the network resources of Claim 22, Saylor does not disclose earning credits in return for contributing that content to a VNAP. Instead, Saylor discloses sharing revenue with a content provider only after a user has paid to access the content. *E.g., Saylor at 5:58-67.* Thus, content providers in Saylor do not receive credits merely by providing content to a VNAP.

The Examiner has not cited any evidence that shows otherwise. Indeed, the Examiner even admits that revenue in Saylor is dependent on users accessing content when he explains that Saylor teaches a “method for generating revenue from providing pages of voice content *when users input a voice code corresponding to that content.*” *Examiner’s Answer at pp. 4-5* (emphasis added).

Because Saylor does not disclose earning credits by contributing network resources to a network, it does not render obvious Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

3. Saylor does not disclose a distributed system for publishing and retrieving content.

Claim 22 recites, “[a] distributed system for publishing and retrieving content in a network.” Saylor does not disclose this claim limitation and the Examiner has not cited any evidence that shows otherwise.

A distributed system consist of “a group of non-alike computers that are connected together by a network and equipped with corresponding software so that the computers can coordinate their activities in a common scheme.” *Appellant’s Specification as published, para. 41.* As discussed in the appellant’s appeal brief, Saylor does not disclose such a system. *Appeal Brief at p. 5.*

The Examiner has not cited any evidence that shows otherwise. In the Examiner’s Answer, he explains that Saylor discloses a distributed system because a fee collected from a user “may be distributed between participants with the [VNAP] system.” *Examiner’s Answer at p. 5.* But a system for distributing fees among users is different than the distributed system of the pending claims. As a basic level, the distributed system of the pending claims refers to a group

of computers configured in a particular way, not an abstract method of allocating fees, even if the process of allocating fees is accomplished with the help of computers. Moreover, the distributed system of the present claims requires multiple computers coordinating their activities in a common scheme. Nothing in Saylor suggests that fee distribution is accomplished by multiple, coordinated computers. Finally, the distributed system of the pending claims is used for publishing and retrieving content, which is distinguishable from distributing the fees generated as a result of publishing content.

Because Saylor does not disclose a distributed system for publishing and retrieving content, it does not render obvious Claim 22 or the claims that depend on Claim 22.

Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

4. Saylor does not disclose publishing and retrieving content via peer-to-peer interactions.

Claim 22 recites, “[a] distributed system for publishing and retrieving content in a network comprising: a plurality of computer systems connected together in a peer-to-peer fashion ... for performing peer-to-peer interactions across the network.” Saylor does not disclose this claim limitation and the Examiner has not cited any evidence that shows otherwise.

As explained in the appellant’s appeal brief, Saylor discloses publishing and retrieving content using a *client-server* model rather than a *peer-to-peer* model. *Appeal Brief at p. 5*. The Examiner does not specifically address this argument in his Answer. Rather, the Examiner merely describes the system shown in Saylor Figures 1 and 2. *Examiner’s Answer at p. 3*. As explained in the appellant’s appeal brief, however, these figures show a client-server system rather than a peer-to-peer system. Specifically, the Saylor users must access VPage content by accessing some server or VNAP, not by interacting with other users (their peers). *See Appeal*

Brief at p. 5.

Because Saylor does not disclose publishing and retrieving content via peer-to-peer interactions, it does not render obvious Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

5. Saylor does not disclose agent applications distributed across the network.

Claim 22 recites, “one or more agent applications distributed across the network … for allowing the computer systems to publish content to and retrieve content from the network by initiating peer-to-peer interactions.” Saylor does not disclose this claim limitation and the Examiner has not cited any evidence that shows otherwise.

As explained in the appellant’s appeal brief, Saylor discloses a plurality of modules to enable delivery of content to users. *Appeal Brief at p. 7* (citing *Saylor at 18:10-12*). These modules, however, are centralized at a VNAP, not distributed across a network. *Appeal Brief at p. 7* (citing *Saylor at Fig. 2*). Thus, Saylor does not disclose agent applications distributed across a network.

The Examiner does not address this argument in his Answer. The Examiner’s claim chart omits the entire second clause of Claim 22, which contains this limitation. *See Examiner’s Answer at p. 3.* The Examiner’s remarks do not address this argument either. *Id. at pp. 4-5.* Thus, the Examiner has provided no evidence that Saylor discloses this limitation.

Because Saylor does not disclose agent applications distributed across a network, it does not render obvious Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

6. The Examiner has not overcome the deficiencies of Saylor because his obviousness argument has no evidentiary support.

In the Final Office Action of January 9, 2006, the Examiner admits that Saylor does not disclose the recited claim limitation, “any of disk space, bandwidth, and CPU cycles for performing peer-to-peer interactions across the network.” *Office Action of Jan. 9, 2006 at pp. 3-4.* In an attempt to overcome this deficiency of Saylor, the Examiner summarily concludes that it would have been obvious to modify the teachings of Saylor to include this limitation. *Id. at p. 4.* As explained in the appellant’s appeal brief, however, the Examiner’s conclusion has no evidentiary support in the record and therefore contravenes Federal Circuit precedent. *Appeal Brief at p. 8* (citing *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001)).

The Examiner did not address this issue in his Answer and therefore has provided no evidence that his obviousness argument has evidentiary support. Because the Examiner’s obviousness argument has no evidentiary support, it cannot be used to reject Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

7. The Examiner has provided no motivation to modify Saylor.

Even if, *assuming arguendo*, the claim limitation “any of disk space, bandwidth, and CPU cycles for performing peer-to-peer interactions across the network” had proper evidentiary support, the Examiner has provided no motivation to modify the teachings of Saylor to include this limitation.

The Supreme Court recently re-emphasized that “a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 167 L. Ed. 2d 705, 722

(2007). This is so because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* Instead, there must be “an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *Id.* Moreover, any analysis that concludes that such a reason exists “should be made explicit.” *Id.*

As explained in the appellant’s appeal brief, however, the Examiner has not attempted to provide a motivation to modify the teachings of Saylor to include the above limitation. *See Appeal Brief at p. 10.* Nor has the Examiner attempted to provide such a motivation in his Answer.

Because the Examiner has not even attempted to provide a motivation to modify the Saylor reference, the proposed modification cannot be used to reject Claim 22 or the claims that depend on Claim 22. Accordingly, the Board should overturn the § 103(a) rejection of the pending claims.

B. Claim 22 particularly points out and distinctly claims the subject matter that the appellant regards as the invention, as required by 35 U.S.C. § 112, second paragraph.

The Examiner has rejected Claim 22 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention. Specifically, the Examiner has rejected the claim limitation “having characterized network resources including ...” as being vague and indefinite. *Office Action of Jan. 9, 2006 at p. 2.*

The Board should overturn this rejection because the Examiner has provided no analysis as to why the claim limitation is indefinite, and because the scope of Claim 22 would be clear to a person possessing the ordinary level of skill in the pertinent art.

1. The record contains no basis for rejecting Claim 22 as indefinite.

As an initial matter, the Manual of Patent Examination and Procedure (“MPEP”) instructs an Examiner who is making a rejection under 35 U.S.C. § 112, second paragraph, to provide “an analysis as to why the phrase(s) used in the claim is ‘vague and indefinite.’” MPEP § 2173.02. As explained in the appellant’s appeal brief, however, the Examiner has not done so. *See Appeal Brief at p. 10.*

Nor has the Examiner provided such an analysis in his Answer. Although the Examiner says that the appellant has not defined the claim limitation, this alone does not make it indefinite. Only claim terms that are indefinite require definitions by the applicant to be patentable. Thus, the Examiner’s argument that the claim limitation is indefinite because it is not defined is based on circular logic and cannot support a rejection under 35 U.S.C. § 112, second paragraph. Accordingly, the Board should overturn the indefiniteness rejection of Claim 22.

2. Claim 22 is definite because it has a reasonable degree of particularity and because one skilled in the art would understand what is claimed when reading the claim in light of the specification.

As explained in the appellant’s appeal brief, Claim 22 is definite because it has a reasonable degree of particularity and because one skilled in the art would understand what is claimed when reading the claim in light of the specification. *See Appeal Brief at pp. 11-13.* The Examiner did not address this argument in his Answer and therefore has provided no evidence that the claim does not have a reasonable degree of particularity or would not be understood by

one of skill in the art. Accordingly, the Board should overturn the indefiniteness rejection of Claim 22.

C. **Conclusion**

In view of the foregoing arguments, Claim 22 meets the definiteness requirements of 35 U.S.C. § 112, second paragraph, and Claims 22 and 24-38 are patentable over Saylor and all proposed modifications of Saylor.

The Commissioner is authorized to charge any additional fees which may be required, including petition fees and extension of time fees, to Deposit Account **No. 07-1896** referencing Attorney Docket **No. 350176-991101**.

Respectfully submitted,

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